

### REMARKS/ARGUMENTS

In the Final Office Action of November 23, 2005, Claims 1-2, 4-7, 9-34, 36-39, 41-54, 56-64, 66-80 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,571,220 B1 ("Ogino et al."); and Claims 8, 35, 40 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino et al. in view of NPL to Stallings ("Stallings").

**1. Rejection of Claims 1-3, 4-7, 9-34, 36-39, 41-54, 56-64, 66-80 under 35 U.S.C. 102(e).**

It is well established that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See, e.g., Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As will be explained herein, each of the rejected claims has at least one element that is neither found nor suggested in Ogino et al.

Also, it is well established that the elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

As will also be explained herein, the Final Office Action rejects the claims by improperly arranging elements that it asserts teaches those of the claims. In brief, applicants' preprocessing unit performs certain copy-once functionality on material before providing

the material to a recording unit which then searches the material for a copy-never indication and copies the material unless the copy-never indication is found.

In rejecting the claims, the Final Office Action takes the position that Ogino et al.'s Compliant Recording Apparatus 200 teaches applicants' preprocessing unit, and Ogino et al.'s Compliant Reproducing Apparatus 100 teaches applicants' recording unit. However, in order for these elements to be arranged as required by the claims, Ogino et al.'s Compliant Recording Apparatus 200 would have to provide the material to Ogino et al.'s Compliant Reproducing Apparatus 100, which is clearly in an opposite direction than that shown in Ogino et al.

a. **Claim 1 is patentable under 35 U.S.C. 102(e)**

i. **Ogino et al. fails to teach the recording unit of Claim 1**

Claim 1 claims a recording unit that is "coupled through a secure channel to said preprocessing unit output to receive said material from said preprocessing unit, and capable of searching for a copy-never indication in said material provided on said preprocessing unit output and copying said material unless said copy-never indication is found, but lacking capability to remark said material with a copy-no-more indication."

Thus, in order to teach Claim 1's recording unit, the device being relied upon in the reference must receive material (that is to be copy protected) from a preprocessing unit

(such as claimed in Claim 1) over a secure channel. Ogino et al., however, fails to teach or suggest such a recording unit.

The Final Office Action asserts that Ogino et al.'s Compliant Reproducing Apparatus 100 teaches Claim 1's recording unit by its references to Col. 6, lines 39-51 and Col. 15, lines 48-65, which describe operational aspects of the Compliant Reproducing Apparatus 100.

In FIG. 1 of Ogino et al., however, the Compliant Reproducing Apparatus 100 is clearly shown to receive its material from an inserted ROM or RAM Disc, such as DVD-RAM Disc 3 and illegally copied Disc 7. Neither of these Discs performs the functions of the preprocessing unit of Claim 1, nor do they provide material to the Compliant Reproducing Apparatus 100 through a secure channel, as required in Claim 1. Similarly, in FIG. 16 of Ogino et al., the Compliant Reproducing Apparatus 100 is clearly shown to receive its material from a RAM Disc 42.

Thus, Ogino et al.'s Compliant Reproducing Apparatus 100 does not receive material (that is to be copy protected) from a preprocessing unit (such as claimed in Claim 1) over a secure channel. Therefore, Ogino et al. fails to teach Claim 1's recording apparatus by its Compliant Reproducing Apparatus 100.

It is noted that a secure channel is established, however, between the Compliant Reproducing Apparatus 100 and the Compliant Recording Apparatus 200. However, in

this case, the material is provided from the Compliant Reproducing Apparatus 100, not to it, and therefore, does not teach the recording unit as claimed in Claim 1.

It is also noted, even though the Final Office Action does not assert such a position, that the Compliant Recording Apparatus 200 does not teach the recording unit of Claim 1 since its WM Rewriting Unit 207 superimposes a "No More Copy" on the material (see, Col. 11, lines 3-35), which is contrary to the recording unit of Claim 1 which is "lacking capability to remark said material with a copy-no-more indication."

Accordingly, neither the Compliant Reproducing Apparatus 100 nor the Compliant Recording Apparatus 200 teaches the "recording unit" of Claim 1.

**ii. Ogino et al. fails to teach the preprocessing unit of Claim 1**

The preprocessing unit is recited as having an output and being capable of providing copy-once functionality on a material before providing the material on its output. Copy-once functionality is further recited as including the following elements:

1. searching for a copy-once indication and a copy-no-more indication in said material,
2. not providing said material on said preprocessing unit output if said copy-no-more indication is found, and
3. remarking said material with said copy-no-more indication before providing said material on said preprocessing unit output if said copy-once indication is found and said copy-no-more indication is not found.

In rejecting Claim 1, paragraph 6 of the Final Office Action asserts that each of the following sections of Ogino et al. discloses the “preprocessing unit” of Claim 1:

1. Col. 10, lines 1-6,
2. Col. 5, lines 39-47, and
3. FIG. 14 item S305.

Applicants respectfully submit, however, that none of these sections supports the assertion.

First of all, each of the cited sections refers to a different apparatus in Ogino et al., none of which completely teaches the preprocessing unit and its interaction with the recording unit as claimed in Claim 1. In particular, Col. 10, lines 1-6 describes action taken by a Set Top Box shown in FIG. 2 (see, Col. 7, line 23 to Col. 10, line 6); Col. 5, lines 39-47 describe operation of a Compliant Recording Apparatus (see, Col. 5, line 43) such as shown in FIG. 6 (see, Col. 10, line 7 to Col. 12, line 37); and FIG. 14 item S305 describe action taken by a Compliant Reproducing Apparatus (see, Col. 12, line 38 to Col. 17, line 17) such as shown in FIG. 10. The relationship and interoperation of these three different apparatuses can be seen, for example, in FIG. 21, wherein the Set Top Box is abbreviated as “STB”.

Although the Set Top Box may perform the task of “searching for a copy-once indication and a copy-no-more indication in said material”, it does not perform the task of “marking said material with said copy-no-more indication before providing said material on said preprocessing unit output if said copy-once indication is found and said copy-no-more indication is not found.”

An inspection of the block diagram of the Set Top Box in FIG. 2 and a reading of its description clearly show that there is no watermark (WM) rewriting or adder unit in the Set Top Box. Although FIG. 3 describes the superimposition of the code string PNa on a broadcast signal, this superimposition has already been performed prior to the Set Top Box receiving the signal. See, Col. 7, lines 1-16. The Set Top Box does not place this code string on the broadcast signal.

Accordingly, the Set Top Box does not teach the “preprocessing unit” of Claim 1.

Likewise, the Compliant Reproducing Apparatus as shown in FIG. 10 also does not perform the task of “remarking said material with said copy-no-more indication before providing said material on said preprocessing unit output if said copy-once indication is found and said copy-no-more indication is not found.” In particular, the WM adder 109 of the Compliant Reproducing Apparatus of FIG. 10 only generates a “Never Copy” indication. See, Col. 13, lines 35-65.

Accordingly, the Compliant Reproducing Apparatus does not teach the “preprocessing unit” of Claim 1.

Claim 1 is therefore believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. since Ogino et al. fails to teach either of the preprocessing unit or the recording unit of Claim 1 for the foregoing reasons.

**a. Claims 2, 4-7, and 9-21 are patentable under 35 U.S.C. 102(e)**

Claims 2, 4-7 and 9-21 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 1, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 1.

Further, Claim 10 recites a recording unit that is “capable of communicating information of finding said copy-once indication back to said preprocessing unit if a secure channel is established between said recording unit and said preprocessing unit”, and such capability of communication, or the desirability of such, from the recording unit back to the preprocessing unit is neither taught nor suggested in Ogino et al. In particular, the only secure channel arguably shown in Ogino et al. is the IEEE 1394 I/F secure bus between the Compliant Reproducing Apparatus 100 and Compliant Recording Apparatus 200 in FIGS. 1 and 16, and there is nothing in Ogino et al. to teach or suggest that information ever flows in a backward direction on this bus.

Also, with respect to Claims 15, 16, 17 and 19, the terms “expansion board”, “video capture board”, “network board”, and “network appliance” are not found in Ogino et al., and the references cited in the Office Action with respect to these claims fail to teach or suggest such items. Further, even if an argument could be made that the IEEE 1394 I/F secure bus suggests the need for a network board, there is still nothing to teach or suggest that the network board in that case would be an “expansion board” or that the preprocessing function as claimed in Claim 1 would be included on that board. Also, since the Final Office Action takes the position that the “preprocessing unit” of Claim 1 is taught by the Compliant Recording Apparatus of Ogino et al., it is not even suggestible

that such an apparatus, which generates a RAM disc as its output, may be implemented in an expansion board on a personal computer since an optical disc drive is needed to perform that function.

**c. Claim 22 is patentable under 35 U.S.C. 102(e)**

Claim 22 recites a method implemented in a recording unit including the function “if said copy-once indication is detected, then transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material,” and such transmission back to a sender of the material is neither taught nor suggested in Ogino et al.

Although the Final Office Action asserts in its paragraph 19 that this function is disclosed in Col. 12, lines 19-29 of Ogino et al., a careful reading of that paragraph fails to teach or suggest the function. In particular, the cited paragraph describes step S105 of FIG. 9 in which the CGMS rewriting unit 206 and the WM rewriting unit 207 of the compliant recording apparatus 200 respectively rewrite the CGMS information from (10) to (11) and the electronic watermark information WM to “No More Copy”. There is no discussion in Ogino et al. of transmitting a copy-once (i.e., “One Copy”) indication back to the sender of the material as claimed in Claim 22.

Also, although the Final Office Action also refers in its paragraph 3 to Col. 16, line 63 to Col. 17, line 9, and Col. 17, lines 43-59 in reference to Claim 22, such sections of Ogino



et al. also fail to teach the function “if said copy-once indication is detected, then transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material.”

Accordingly, Claim 22 is believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

**d. Claims 23-34, 36-39 and 41 are patentable under 35 U.S.C. 102(e)**

Claims 23-34, 36-39 and 41 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 22, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 22, as well as any applicable reasons stated in reference to Claims 10, 15, 16, 17 and 19.

**e. Claim 42 is patentable under 35 U.S.C. 102(e)**

Claim 42 has been amended to recite a recording unit including an input channel receiving a material for copying from a sending unit, and compliance logic configured such that “if either said copy-never or said copy-once indication is detected, then providing information of such detection back to said sending unit,” and such a recording unit is neither taught nor suggested by Ogino et al. for at least the reasons stated in reference to Claims 10 and 22 above. Further, paragraph 35 of the Final Office Action

fails to even recite the previous language of “providing information of such detection back to a sender of said material”, let alone identify where it is disclosed in Ogino et al.

Accordingly, Claim 42 is believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

**f. Claims 43-54 and 56-63 are patentable under 35 U.S.C. 102(e)**

Claims 43-54 and 56-63 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 42, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 42, as well as any applicable reasons stated in reference to Claims 10, 15, 16, 17 and 19.

**g. Claim 64 is patentable under 35 U.S.C. 102(e)**

In Claim 64, the recording unit of the claimed system includes compliance logic configured such that “if said copy-once indication is detected, then establishing a secure channel with said preprocessing unit and passing information of said detection of said copy-once indication back to said preprocessing unit over said secure channel”, and Ogino et al. fails to teach or suggest such compliance logic (passing information back to the preprocessing unit from the recording unit) for at least the reasons stated in reference to Claim 10, 22 and 42.

In rejecting Claim 64, paragraph 49 of the Final Office Action identifies the Compliant Recording Apparatus as performing the functions of the “preprocessing unit” of Claim 64 (see, reliance on Col. 11, line 65 to Col. 12, line 10, which describe operation of the Compliant Recording Apparatus), and the Compliant Reproducing Apparatus as performing the functions of the “recording unit” of Claim 64 (see, reliance on Col. 12, 42-48, Col. 13, lines 15-34 and Col. 14, lines 24-41 describing operation of the Compliant Reproducing Apparatus).

As explained in reference to Claim 1, however, material to be recorded is not passed in Ogino et al. from the Compliant Recording Apparatus to the Compliant Reproducing Apparatus over a secure channel. Instead, it passes in the other direction, from the Compliant Reproducing Apparatus to the Compliant Recording Apparatus over a secure channel (see, FIG. 1 and FIG. 16). So this usage of a secure channel (i.e., sending information “back” over the secure channel) is also neither taught nor suggested in this case if the preprocessing unit is considered to be the Compliant Recording Apparatus and the recording unit is considered to be the Compliant Reproducing Apparatus.

It is also noted that paragraph 49 also attempts to alternatively identify the Set Top Box 1 as the recording unit of Claim 64, but such attempt is flawed for the same reasons as stated in reference to the Compliant Reproducing Apparatus 100 (i.e., information is passed in the other direction – from the Set Top Box 1 to the Client Recording Apparatus 400). So this usage of a secure channel (i.e., sending information “back” over the secure channel) is also neither taught nor suggested in this case if the preprocessing unit is

considered to be the Compliant Recording Apparatus and the recording unit is considered to be the Set Top Box.

Accordingly, Claim 64 is believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

**h. Claims 66-80 are patentable under 35 U.S.C. 102(e)**

Claims 66-80 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 64, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 64, as well as any applicable reasons stated in reference to Claims 10, 15, 16, 17 and 19.

**i. New Claims 81-86 are patentable under 35 U.S.C. 102(e)**

New Claims 81-86 have been added, and are believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for at least the same reasons stated in reference to Claim 1 above.

**2. Rejection of Claims 8, 35, 40 and 55 under 35 U.S.C. 103(a).**

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

Claim 8 is believed to be patentable under 35 U.S.C. 103(a) over Ogino et al. in view of Stallings since it depends from Claim 1, and as such is believed to be patentable for at least the same reasons as stated in reference to Claim 1, since Stallings also fails to teach or suggest the elements of that claim which are neither taught nor suggested by Ogino et al.

Claims 35 and 40 are believed to be patentable under 35 U.S.C. 103(a) over Ogino et al. in view of Stallings since they depend from Claim 22, and as such are believed to be patentable for at least the same reasons as stated in reference to Claim 22, since Stallings also fails to teach or suggest the elements of that claim which are neither taught nor suggested by Ogino et al.

Claim 55 is believed to be patentable under 35 U.S.C. 103(a) over Ogino et al. in view of Stallings since it depends from Claim 42, and as such is believed to be patentable for at least the same reasons as stated in reference to Claim 42, since Stallings also fails to teach or suggest the elements of that claim which are neither taught nor suggested by Ogino et al.

### **Conclusion**

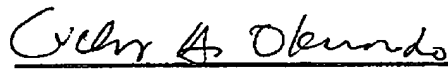
Claims 1, 2, 4-64, 66-80 and new claims 81-86 are pending in the application.

Reconsideration of the rejected pending claims is respectfully requested for the reasons

herein stated, and an early notice of their allowance earnestly solicited. If it would expedite the prosecution of this application, the Examiner is encouraged to contact the undersigned attorney at any time to further discuss or clarify any arguments made by applicants in this communication.

Respectfully submitted,

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